

### REMARKS

The Office Action of August 11, 2008, has been received and reviewed.

Claims 1, 2, 4-10, 18, and 19 are currently pending and under consideration in the above-referenced application. Each of claims 1, 2, 4-10, 18, and 19 has been rejected.

Reconsideration of the above-referenced application is respectfully requested.

### Notice of References Cited

Please note that on page 2 of the outstanding Office Action, U.S. Patent 4,685,802 to Kremer et al. (hereinafter "Kremer") was cited in a rejection under 35 U.S.C. § 103(a). Kremer has not, however, been officially made of a record in the above-referenced application (*i.e.*, by way of a Form PTO-892). It is respectfully requested that Kremer be made of record in the above-referenced application, that a Form PTO-892 evidencing consideration of Kremer be entered into the above-referenced, and that a copy of the Form PTO-892 be returned to the undersigned attorney.

### Drawings

Replacement sheets of drawings are being submitted with this Amendment. The replacement sheets include formalized drawings, with no other changes.

### Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 4-10, 18, and 19 have been rejected under 35 U.S.C. § 103(a)

There are several requirements in establishing a *prima facie* case of obviousness against the claims of a patent application. All of the limitations of the claim must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Even then, a claim "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). The Office must also establish that one of ordinary skill in the art would have had a reasonable expectation of success that the purported modification or combination of reference teachings would have been successful. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed.

Cir. 1986). There must also be “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR* at 1396. That reason must be found in the prior art, common knowledge, or derived from the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006). A mere conclusory statement that one of ordinary skill in the art would have been motivated to combine or modify reference teachings will not suffice. *KSR* at 1396.

#### Mark, Kremer and Bobo

Claims 1, 2, 4, 5, 8, 9, 18, and 19 are rejected under 35 U.S.C. § 103(a) for reciting subject matter that is allegedly not patentable over the subject matter taught by U.S. Patent 6,238,120 to Mark (hereinafter “Mark”), in view of teachings from Kremer or from U.S. Patent 6,637,967 to Bobo et al. (hereinafter “Bobo”).

Mark teaches a system for dispensing and applying small amounts of liquid onto intended targets. Col. 1, lines 5-7. The system of Mark includes a reservoir 23, 40, 41 for the liquid. A female coupling element is located at one end of the reservoir. The female coupling element is configured to receive and couple to a male coupling element of an applicator 10. The opposite end of the applicator 10 includes an elongate extension 17 with flocked ball 20 at the tip thereof. Upon reducing a volume of the reservoir 23, 40, 41, fluid is forced through the elongate extension 17 of the fluid applicator 10 and onto the flocked ball 20, with the liquid apparently wetting the flocked ball 20. *See, e.g.*, Col. 2, lines 27-30; col. 3, lines 15-16. Mark does not teach or suggest that a semisolid material may be used in place of the liquid. For this reason, the Office has relied upon teachings from Kremer and Bobo.

Like Mark, Kremer teaches an applicator device for dispensing a material onto a surface. Col. 3, lines 46-51. The applicator device of Kremer includes a valve that controls “the flow of applicator material from [a] container means to [a] surface applicator.” Col. 3, lines 55-60. glue/adhesive dispenser.

Bobo also teaches an applicator. The applicators of Bobo include porous applicator tips with flow paths, or grooves, that control the flow of flowable, liquid adhesive. *See, e.g.* col. 3.

lines 15-22 and 34-41. Bobo does not teach or suggest that the adhesive may be semisolid, as the Office has asserted. Rather, Bobo, at col. 10, line 58, to col. 11, line 10, teaches that a semisolid material may be applied to portions of the applicator tip to prevent adhesive from flowing through the coated portions of the applicator tip.

It is respectfully submitted that none of Mark, Kremer, or Bobo teaches or suggests several elements of the hand-held pick and place apparatus of independent claim 1, as amended.

For example, none of Mark, Kremer, or Bobo provides any teaching or suggestion of a semisolid material that remains associated with a device by protruding from a tip thereof to provide a *grasping element*. Rather, the teachings of Mark, Kremer, and Bobo are limited to devices that *dispense flowing liquids*. Dispensed materials do not remain associated with the tip of an applicator.

Also, none of Mark, Kremer, or Bobo teaches or suggests that a piece of material, such as paper, may adhere to the tip of the applicator (*e.g.*, the flocked ball 20 of Mark) once a dispensed material is present at the tip of the applicator. Instead of describing that fluid of the disclosed devices may be used to adhere to “a piece to be picked,” Mark, Kremer, and Bobo merely teach the application of small amounts of liquids to objects.

Further, none of Mark, Kremer, or Bobo teaches or suggests that the grasping element may adhere to “a piece to be picked while leaving substantially no residue on the piece...” Instead, the teachings of Mark, Kremer, and Bobo are limited to devices that apply small amounts of liquid to objects, intentionally leaving residue on the objects.

In addition, the devices of Mark, Kremer, and Bobo lack tips that, when rotated relative to a body (*e.g.*, the reservoir 23, 40, 41), will define “a position of the end for adhesion of the grasping element relative to a free end of the tip.” Rather, when the applicators of Mark, Kremer, and Bobo are used, flowable material is dispensed therefrom; *i.e.*, becomes disassociated from the applicator.

In view of the foregoing, it is respectfully submitted that Mark does not teach or suggest each and every element of amended independent claim 1.

Furthermore, it is respectfully submitted that one of ordinary skill in the art would have no reason to expect that a non-flowing material, as recited by amended independent claim 1,

could be forced through the tip of any of the applicators of Mark, Kremer, or Bobo. In Mark, such a material would have to be forced through a flocked ball. In Kremer, such a material would have to be forced through a small space past a valve. In Bobo, such a material would have to be forced through a porous material and allowed to flow along small grooves. One of ordinary skill in the art would expect it to be impossible, or at least extremely difficult, to perform any of these activities with a non-flowing material.

Therefore, it is respectfully submitted that the Office has not established a *prima facie* case of obviousness against independent claim 1.

Claims 2, 4, 5, 8, and 9 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

With respect to the subject matter recited in independent claim 18, as amended, it is respectfully submitted that the fluid applicators of Mark, Kremer, and Bobo lack grasping elements, let alone grasping elements that comprise non-flowing, semisolid materials.

Additionally, Mark, Kremer, and Bobo lack any teaching or suggestion of body-engagement elements that are “configured... to be rotated relative to [a] body [of a pick-and-place apparatus] so as to cause the grasping element to be extruded from the tip or retracted therein.” The only purpose for rotating the fluid applicator 10 of the fluid application system of Mark relative to the reservoir 23, 40, 41 of that fluid application system is to secure the fluid applicator 10 to the reservoir 23, 40, 41. The only ways that fluid may be forced through the fluid applicator 10 that are described in Mark are by forcing a plunger 25 through the barrel 23 of a syringe, or by squeezing a reservoir 41 like an eye dropper. Col. 2, lines 27-30; col. 3, lines 15-16. The applicator of Kremer includes a depressable distal end 97 that opens a valve body 34 and allows flowable material to flow out of a surface applicator 18; nothing is rotated. Col. 9, lines 1-20. Flowable material is apparently dispensed from the applicator of Bobo by squeezing, not rotation.

Thus, Mark, Kremer, and Bobo do not anticipate each and every element of amended independent claim 18.

Moreover, as noted above, there would have been no reasonable expectation by one of ordinary skill in the art the teachings of Mark, Kremer, and Bobo could have been successfully combined in the manner that has been asserted by the Office.

Therefore, it is respectfully submitted that the teachings of Mark, Kremer, and Bobo do not support a *prima facie* case of obviousness against independent claim 18, as would be required to maintain the 35 U.S.C. § 103(a) rejection of that claim.

Claim 19 is allowable, among other reasons, for depending directly from independent claim 18, which is allowable.

Mark, Kremer, Bobo and Otake

Claims 6, 7, and 10 stand rejected under 35 U.S.C. § 103(a) for being drawn to subject matter that is assertedly unpatentable over teachings from Mark, in view of teachings from Kremer or Bobo, and, further, in view of the subject matter taught by U.S. Patent 5,388,726 to Otake (hereinafter “Otake”).

Claims 6, 7, and 10 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claim 7 is further allowable since none of Mark, Kremer, Bobo, or Otake teaches or suggests a cap that is configured to rotate a tip when the cap is secured to the tip.

Seymour, Kremer and Bobo

Claims 1, 2, 4-10, 18 and 19 have been rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is purportedly unpatentable over the teachings of U.S. Patent 6,293,431 to Seymour et al. (hereinafter “Seymour”), in view of teachings from Kremer or Bobo.

Seymour teaches a container 2 for dispensing “pasty products,” such as joint sealers and other caulks. Col. 1, lines 16-19. An outlet nozzle 1 may be coupled to an opening of the container 2 by an annular part 4. The outlet nozzle 1 includes an elongate part 5 through which an outlet channel 3 is defined. The outlet channel 3 communicates with the opening of the container 2. A closure cap 15 is configured to be positioned over the elongate part 5 and coupled

to the annular part 4 to seal outlet channel 3. Once the contents of the container 2 have been exposed through the outlet channel 3, the closure cap 15 also seals the container 2 and its contents. The closure cap 15 may include a piercing member 16 that, when the closure cap 15 is first disposed over the elongate part 5, pierces a membrane at an end of the elongate part 5 to open the outlet channel 3 and, thus, to enable extrusion of the contents of the container 2 through the outlet channel 3. Once the membrane of the elongate part 5 has been pierced, extrusion of the container 2's contents may be prevented (*i.e.*, the container 2 may be sealed) by recoupling the closure cap 15 and the annular part 4.

Like the applicators of Mark, Kremer, and Bobo, the apparatus of Seymour merely dispenses fluids. Although those fluids may include adhesive materials, Seymour provides no teaching or suggestion that the container may hold “a grasping element including an end for adhesion to a piece to be picked...” Instead of being used to adhere to objects, the fluid within the apparatus of Seymour is configured to be applied to objects.

Nor does Seymour teach or suggest a grasping element that will leave “substantially no residue on the piece.” Rather, when an adhesive is dispensed from the container of Seymour and onto an object, a residue of the adhesive material will certainly remain on the object.

Seymour also lacks any teaching or suggestion of the manner in which fluid is extruded from the container 2. More specifically, Seymour does not teach or suggest that rotation of the elongate part 5 relative to the container 2 “define[s] a position of [an] end for adhesion of [a] grasping element relative to a free end of the tip” of the elongate part 5. Independent claim 1. It is instead presumed that fluid is removed from the container 2 by squeezing the container 2 or by use of a piston to force fluid from the container. *See, e.g.*, col. 1, lines 16-20.

As neither Kremer nor Bobo provides any teaching or suggestion of these elements of independent claim 1, it respectfully submitted that none of Seymour, Kremer, or Bobo, taken individually or in combination, supports a *prima facie* case of obviousness against independent claim 1, as would be required to maintain the 35 U.S.C. § 103(a) rejection of that claim.

Each of claims 2 and 4-10 is allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Independent claim 18 is allowable since none of Seymour, Kremer, or Bobo provides any teaching or suggestion that the disclosed system includes a grasping element or a body-engagement element that is “configured... to be rotated relative to [a] body [of a pick-and-place apparatus] so as to cause the grasping element to be extruded from the tip or retracted therein.” The only apparent reason to rotate the elongate part 5 of the system of Seymour relative to the container 2 is to secure the elongate part 5 to the container. Thus, a *prima facie* case of obviousness cannot be established against independent claim 18 on the teachings of Seymour, Kremer, and Bobo.

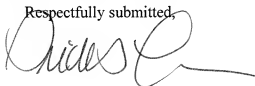
Claim 19 is allowable, among other reasons, for depending directly from independent claim 18, which is allowable.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1, 2, 4-10, 18, and 19 is respectfully solicited, as is the allowance of each of these claims.

### CONCLUSION

It is respectfully submitted that each of claims 1, 2, 4-10, 18, and 19 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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